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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Finnegan Henderson Farabow Garrett and Dunner  
Franklin Square Bldg  
1300 I Street N.W.  
Suite 700  
Washington, DC 20005-3315

EXAMINER

BEX, PATRICIA K

ART UNIT

PAPER NUMBER

1743

7

DATE MAILED: 02/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/551,581

Applicant(s)

OTTO ET AL.

Examiner

P. Kathryn Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 7-11 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 10, recites "a traction drive", however, the specification does not support "a traction drive" for moving the pipette-needle carrier.

### ***Claim Objections***

3. Claims 8-11 are objected to as being in improper form because they depend either directly or indirectly from previously cancelled claim 1. However, claims 8-11 have been treated on the merits. Examiner has assumed "claim 1" should be --claim 7-- and "claim 2" should be --claim 8--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, line 7, recites the limitation "the reaction containers". There is insufficient antecedent basis for this limitation in the claim. No positive recitation of the reaction containers is disclosed within the instant claims.

Claims 8-11, are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. It is not clear as to how the structure for translating movement imparts movement to the pipette and plunger through the use of the recited elements; two rocker arms, stop rod, traction drive, thrust plate and catch member and how these elements are related to each other. Examiner assumes the movement of the pipette and opening apparatus are connected, however how this is accomplished is not definite.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Abrams (USP 4,807,425).

Abrams teaches a method and device for opening and closing vials 10. The apparatus includes a cap opener positioned 42 relative to rack conveyor. The rack conveyor having a plurality of vials and transporting the vials along the test equipment 36, i.e. pipette 3. Abrams teach that the pipette have variable speed drive mechanisms such that the speed of the test equipment can be adjusted. The pipette movement is coordinated with the rack 18 drive mechanism so that the pipette is inserted into and withdrawn from each vial as it passes below the pipette. The cam operating switch mounted adjacent the pipette is triggered by the lowering of the pipette into a vial. A pneumatic structure 41 is connected to and controlled by the cam operating switch. A pneumatic tube leads from the switch to the a "T" connection 51 from which the air is diverted to a regulator of the cap opening mechanism 44, 56. As the pipette is lowered into vial 10A, the disk 44, or plunger, it is quickly raised by the air regulator 48 so that the disk contacts the tab 16, or catch, of the vial 10B. The continued upward movement of the disk unseals the cap 12 from the vial (column 4, line 18- column 5, line 37, Figs. 3-5). Note: claim 8, recites a process limitation disclosing the translated movement of the pipette-needle carrier. Process limitations are not accorded patentable weight in a claim which is directed to an apparatus. Moreover, Examiner believes the device of Abrams is fully capable of performing the recited function.

9. Claims 7-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinohara *et al* (USP 4,455,280).

Shinohara *et al* teach a method and device for opening and closing vessels 14. The apparatus includes a cap opener positioned 22 relative to reagent carousel 15. The carousel having a plurality of vessels and transporting the vessel into position of a pipette 8. The pipette movement is coordinated with the carousel by a controller 1 so that the pipette is inserted into and withdrawn from each vessel when the vessel has been indexed to the predetermined aspirating position. The pipette comprising a drive means 8 for moving the pipette. The controller produces a synchronizing signal to actuate the rotary solenoid to rotate plunger 23 against catch 22 of the vessel (column 4, lines 18-30, Figs. 1-3). Note: claim 8, recites a process limitation disclosing the translated movement of the pipette-needle carrier. Process limitations are not accorded patentable weight in a claim which is directed to an apparatus. Moreover, Examiner believes the device of Shinohara *et al* is fully capable of performing the recited function.

10. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Bienhaus (USP 5,846,489).

Bienhaus *et al* teach a system for opening closures of vessels 1. The system includes a Tecan Company robot 018 having an arm containing the automatic pipetting unit 017 and another arm 2 containing opening and removal device 7. The arms being controlled by a mutual controller and positioned above a vessel rack (column 8, line 46-column 13, line 54, Fig. 5).

### ***Conclusion***


11. No claims allowed.


12. The prior art made of record and not relied upon which is considered pertinent to applicant's disclosure are Otto *et al*, Schwab, Kanbara *et al*, Nishikawa *et al*, Inouye, and Wurschum *et al*. They are cited of interest in that they show methods and devices for opening and closing vials

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 or (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703)872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
P. Kathryn Bex  
Patent Examiner  
AU 1743  
1/31/02

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700